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IN THE

Supreme Court of the United States

OCTOBER TERM, 1963

No. 318

SAFWAY PRODUCTS, INC. AND
R. D. WERNER CO., INC.,

Petitioners,

v.

UP-RIGHT, INC.,

Respondent.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIFTH CIRCUIT

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Respondent.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIFTH CIRCUIT

Petitioners pray that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the Fifth Circuit, entered in the above-entitled case on March 29, 1963.

OPINIONS BELOW

The letter-opinion of the District Court (R. 366-367) is unreported and is printed in Appendix B hereto, *infra*, p. 35; the findings of fact and conclusions of law of the District Court (R. 368-381) are printed in Appendix B

hereto, *infra*, p. 37. The opinion of the Court of Appeals, printed in Appendix B hereto, *infra*, p. 23, is reported in 315 F.2d 23.

JURISDICTION

The judgment of the Court of Appeals was entered on March 29, 1963 (R. 870), Appendix B, *infra*, p. 52. A timely petition for rehearing (R. 871-885) was denied on May 14, 1963 (R. 894). The jurisdiction of this court is invoked under 28 U.S.C. § 1254(1).

QUESTIONS PRESENTED

1. The Court of Appeals ruled inapplicable in this patent suit the provisions of Rule 52(a) of the Federal Rules of Civil Procedure which require that findings of fact be affirmed unless clearly erroneous, and that due regard be given to the opportunity of the trial court to judge of the credibility of witnesses. The Court of Appeals, without holding the findings of fact of the District Court clearly erroneous, reached its own original factual conclusions. The first question presented is whether Rule 52(a), F.R.C.P., is applicable so as to require the affirmance by the Court of Appeals of the findings of non-infringement herein.

2. Whether, upon subsidiary findings of fact by the trier of fact that an alleged infringing machine, as against a machine set forth in patent claims, has such changes in location of its members as to result in entirely different relative motions and intercooperation of the parts thereof, the ac-

cused device as a matter of law is outside the protection to the patentee afforded by his patent claims.

3. Whether so much of an alleged invention as is asserted by a patentee in litigation to be a part of his alleged invention, but which was not claimed as part of the alleged invention in his patent, is in the public domain and available for appropriation by others. Further, whether that same, narrow claim can be expanded to cover the asserted but unclaimed different machine, by the doctrine of equivalents.

4. Whether the doctrine of file wrapper estoppel limits the scope which may now be asserted by respondent for the claims of the patent in suit—

(a) Because the Patent Office required the patentee to relinquish language chosen by him in his original application to describe the feature of his alleged invention which is the feature crucial to the infringement issue herein involved, to narrower, more specific language which is inapplicable to the alleged infringing machine; and

(b) Because of the inconsistently-narrow interpretation of the claims expressly represented by the alleged inventor himself to the Patent Office during the prosecution of the patent application.

5. In addition to the foregoing questions which form the basis for this petition, the following question is presented herein, and petitioners wish to raise the same upon a grant

of certiorari herein: Whether Claims 1 and 2 of Patent No. 2,438,173 are invalid as a matter of law—

(a) If Claims 1 and 2 are stretched by interpretation so as to cover petitioners' accused device;

(b) Alternatively, because the device claimed therein was not patentable in view of the prior art and because involving only the exercise of the ordinary skill of a person familiar with that art.

STATUTES AND RULE INVOLVED

The statutory provisions involved are:

(1) 35 U.S.C. § 271(a):

"Except as otherwise provided in this title, whoever without authority makes, uses or sells any patented invention, within the United States during the term of the patent therefor, infringes the patent."

(2) Rev. Stat. § 4888. (old 35 U.S.C. § 33):

"Before any inventor or discoverer shall receive a patent for his invention or discovery he shall make application therefor, in writing, to the Commissioner of Patents, and shall file in the Patent Office a written description of the same, and of the manner and process of making, constructing, compounding, and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound, and use the same; and in case of a machine, he shall explain the principle thereof, and the best mode in which he has contemplated applying that principle, so as to distinguish it from other inventions; and he shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery."

Also involved is Rule 52(a) of the Federal Rules of Civil Procedure which provides in pertinent part:

> "Findings of fact shall not be set aside unless clearly erroneous, and due regard shall be given to the opportunity of the trial court to judge of the credibility of the witnesses."

STATEMENT

Respondent and its president, Johnson (the alleged inventor), sued petitioner Safway Products, Inc. alleging infringement of Johnson et al. Patent No. 2,438,173 relating to portable, collapsible scaffolding units. Jurisdiction of the District Court was invoked because the case arose under the patent statutes. Petitioner R. D. Werner Co., Inc., manufacturer of the allegedly infringing Aldek folding stairway scaffold, intervened (R. 66). Together, petitioners joined in common defenses asserting invalidity of the Johnson Patent Claims 1 and 2 (to which plaintiffs had limited their complaint at the first pretrial), and non-infringement by the Aldek scaffold of Claims 1 and 2 of the Johnson patent (R. 36, 39, 42, 58).

Claim 1 of the Johnson patent reads as follows (R. 399):

> 1. A scaffold unit comprising a rigid platform section, a rigid supporting section at each end of the platform section, a hinged connection between adjoining ends of the platform and supporting sections, a ladder section hingedly connected at one end to the end of one supporting section at the junction between it and the platform section, and a detachable connection between the other end of the ladder section and the other supporting section at the end of the latter opposite its connection with the platform section."

Claim 2 is identical, except in further providing for a detachable brace extending between the two end sections of the scaffold in order to give it rigidity (R. 399).

The Aldek scaffold (upon which a patent also issued, over the Johnson patent, R. 744) contemplates having the detachable connection which Johnson in all his claims specifically locates at the bottom of his ladder section, at the junction between one end section and the platform section. Where Johnson in all his claims specifically requires a "detachable connection", Aldek has provided a hinge about which one end-frame and the ladder member rotate in the folding operations. In order to achieve flat folding with these differently located connections, the Aldek scaffold requires throughout a completely different relative positioning of the various members from Johnson (R. 397).

The differences in the operative functioning of the respective devices, on account of Johnson's having a detachable connection as specified by Johnson in his claims and employing the relative positioning illustrated in his drawings, and the departure by Aldek therefrom, are shown in actual commercial practice for the Johnson scaffold sequentially in Exhibits DI-4, 3, 2 and 1, (R. 490, 489, 488 and 487, respectively), and as to the Aldek scaffold in Exhibits DI-55 and DI-56 (R. 724, 725). The differing relative inter-cooperation of parts of the devices is shown schematically and with parts differently colored for comparative analysis in Exhibit DI-82 (R. 773). The differences are illustrated diagramatically in the drawing included as part of Appendix

A hereto, *infra*, p. 20, which includes also a columnar comparative summary.

Operation of the devices high in the air is shown at R. 426, 719-20.

Trial was had upon detailed fact issues framed in two pre-trials by the parties (R. 70-76) and finally in proposed findings of fact submitted by the parties before trial to the District Judge as part of trial briefs (*e.g.*, R. 775-824). The trial, to the District Court without a jury, lasted three days. Five live witnesses (including mechanical experts and safety experts) testified (R. 98, 184, 209, 221, 265) and the depositions or prior testimony of eight witnesses were read in part (R. 194-204, 246, 248; 165-183). Many demonstrations of apparatuses were made in the courtroom during trial (*e.g.*, R. 114, 116, 118, 120, 134, 142, 160, 226, 227, 308, 348, 351), and one morning was spent during the trial but off the record in demonstrations and experiments at a local warehouse, witnessed by the Court and the expert mechanical and safety witnesses, with the lower and upper sections of the Johnson scaffold, and of the Aldek scaffold, and other full-size scaffolding exhibits which plaintiffs had themselves prepared and offered in evidence (R. 191-192, 213, 214, 235, 318, 320-321).

The trial below was occupied almost entirely with the irreconcilable testimony* and other evidence of the re-

*On mechanical theory Johnson and Chesnut wholly disagreed. On actual speed and efficiency Johnson differed entirely from Brush and Cannon. Middleditch and Johnson testified on safety facts, but only Closser as an expert; the Court adopted Closser's opinion.

Respondent put in issue Chesnut's credibility—resolved against respondent.

Johnson's credibility too was in issue—resolved against respondent.

spective parties as to the materiality and consequence—in terms of mechanical theory, and of actual efficiency, speed, and safety—of the differences in structure and mode of operation and results accomplished by the Johnson and Aldek equipment. *Kokomo Fence Machine Co. v. Kitselman*, 189 U.S. 8, 24 (1903); *Stewart-Warner Corp. v. Lone Star Gas Co.*, 195 F.2d 645 (5th Cir. 1952).

Under date of June 20, 1961, the Court delivered its letter-opinion (R. 366-367), announcing its decision that the Johnson patent had not been infringed by the Aldek device because:

> "* * * Plaintiff's patent, a combination patent in a very old and crowded art which embodies no new individual elements, is entitled at most to only a very narrow range of equivalents. The accused device does not fall within this range. The Aldek device is simpler, safer and more efficient in operation, and is substantially and materially different in structure, mode of operation, and result."

The District Court's findings of fact (herein called "FF", and reprinted in Appendix B, page 37, *infra*) were in detail to the same effect; and the Court further stated as facts that Aldek "does not have" the Johnson structure, "has an entirely different mode of operation and operative functioning," and "reaches different results" (Conclusion 3, R. 380). The District Court also made detailed findings concerning the prior art and its limiting effect on the scope of the alleged invention as claimed in Johnson Claims 1 and 2 (FF 22-32; R. 376-379). It also found that the actual conception of the alleged inventor was not as asserted by plaintiffs (FF 12, 13; R. 372-373).

FF 14 (R. 373 deals with the Johnson Patent file wrapper (R. 406, 410-11). Johnson in order to secure his patent was required to relinquish the broader term "articulate" for the narrower term "hinged" to describe the connection at the intersection of the platform member and one end-support member, at which intersection Aldek has a detachable connection. The file wrapper also shows that in defining the nature of the invention Johnson represented to the Patent Office that he had a hinged connection at the point in question. In his testimony Mr. Johnson definitely recognized the distinction between a detachable connection and a hinged connection, as did petitioners' mechanical expert (R. 357). The District Court found them not equivalent (FF 16, R. 373).

Judgment for petitioners, holding Johnson Claims 1 and 2 not infringed by the Aldek scaffold, was entered June 30, 1961.

Respondent appealed to the Court of Appeals, which reversed. The Court of Appeals treated the infringement question as a question of law and determinable "free of the clearly erroneous rule." App. B, *infra*, at p. 31. It, accordingly, determined for itself the fact questions involved on the issue of infringement, and found infringement of Claims 1 and 2 by the Aldek scaffold. It held there was no basis for file wrapper estoppel in the case. It announced a rule that the patent was not limited to the "preferred embodiments shown in the claims or drawings." Accordingly it remanded for a determination of validity.

REASONS FOR GRANTING THE WRIT

1. The decision of the Court of Appeals is in conflict with the decisions of this Court in the two cases of *Graver Tank & Mfg. Co. v. Linde Air Products Co.*, 336 U.S. 271 (1949) and 339 U.S. 605 (1950). The findings of the District Court in the case at bar were based on fact inquiries and stipulations emanating from two pre-trials of the action (R. 65-87), and on evidence of record, the numerous demonstrations during trial in and out of the courtroom, and the opportunity of the trial court to judge of the credibility of three conflicting expert witnesses as well as other witnesses.

From these the District Court made comprehensive findings as to the structure, mode of operation and result of the device in Claims 1 and 2 of the Johnson Patent and the Aldek device (FF 7-12, 16-21; R. 370-375). It also found that the subject matter of the alleged invention was not as claimed by Johnson and respondent in this litigation (FF. 12, 13; R. 372-373). It also found that the alleged invention in the claims if so broad as to comprehend Aldek, pre-existed in the prior art (FF. 32; R. 378-379).

This Court in the first *Graver* case, 336 U.S. at 274, 275, said of the provisions of Rule 52(a), F.R.C.P., quoted *supra*, p. 5, in language pointedly applicable here:

> "To no type of case is this last clause more appropriately applicable than to the one before us, where the evidence is largely the testimony of experts as to which a trial court may be enlightened by scientific demonstrations. This trial occupied some three weeks, during which, as the record shows, the trial judge visited laboratories with counsel and experts to observe actual

demonstrations of welding as taught by the patent and of the welding accused of infringing it, and of various stages of the prior art. He viewed motion pictures of various welding operations and tests and heard many experts and other witnesses. He wrote a careful and succinct opinion and made findings covering all the factual issues.

"The rule requires that an appellate court make allowance for the advantages processed by the trial court in appraising the significance of conflicting testimony and reverse only 'clearly erroneous' findings."

There was not any such allowance made by the Court of Appeals in this case. Had the Court of Appeals deemed Rule 52(a) applicable, the record herein would require affirmance of the findings of fact in the trial court, each being overwhelmingly supported and, as we would fully demonstrate in a brief on the merits, required, by an abundance of record evidence. Though applicable generally in patent actions as held in the first *Graver* case, Rule 52(a) is made expressly applicable to findings of fact on the issue of equivalency in the second *Graver* case, *supra*, 339 U.S. at 609-610.

The pretermission of Rule 52(a) by the Court below in the instant case is irreconcilable with the Seventh Circuit decisions in *Kennatrack Corporation v. Stanley Works*, 314 F. 2d 164 (1963) and *Bauer v. Yetter Manufacturing Company*, 315 F. 2d 377 (1963), where patent findings based on physical demonstrations and oral testimony are held to particularly require application of the Rule.

The Court of Appeals deemed itself free of the provisions of Rule 52(a) F.R.C.P., on the authority of its decisions in *Cameron Iron Works, Inc. v. Stekoll*, 242 F.2d 17 (5th Cir.

1952), and *Industrial Instrument Corporation v. Foxboro Co.*, 307 F.2d 783 (5th Cir. 1962). The assumed conditions on which those decisions were invoked by the Court of Appeals, even if proper as exceptions to the *Graver* decisions, are so demonstrably absent from this case that the decision below constitutes a rejection of the authority of *Graver*. A summary of the record basis demonstrating the absence of any such conditions, and of facts called "undisputed" by the court below, is set forth in paragraphs 1-9 of petitioners' petition for rehearing in the Court of Appeals, R. 872-878.

Under the decision by which the Court of Appeals herein declares itself free of Rule 52(a), the Rule is susceptible of being ignored in all patent cases except the few where processes or mechanical operations are unobservable or unseen. Such inoperation of the Rule is not contemplated by the language of, or the principles of judicial administration underlying, Rule 52(a) and this Court's *Graver* decisions thereunder. It likewise is wasteful of the time and energies of the District Courts, of litigants and witnesses, and their counsel, in their efforts to resolve once and finally (in the absence of clear error) fact controversies by traditional means of testimonial and documentary and demonstration evidence. The *de novo* factual decision below in the case at bar merits reversal by this Court in order that these principles of judicial administration be vindicated on behalf of all patent litigants.

2. The Court of Appeals' decision is directly in conflict with the decision of this court in *Cimiotti Unhairing Co. v.*

American Fur Ref. Co., 198 U.S. 399 (1905). That decision establishes as a matter of law that:

> "If, however, such changes of size, form, or *location* effect a change in the principle or mode of operation such as breaks up the relation and co-operation of the parts, this results in such a change in the means as displaces the conception of the inventor, and takes the new structure outside of the patent."*

The Court of Appeals decision is also conflicting with the rules announced in and the principles governing the decisions of the Seventh Circuit in *Dalton Adding Mach. Co. v. Rockford Milling Mach. Co.*, 267 Fed. 422, 427 (1920) and the Second Circuit in *Read Mfg. Co. v. Hobart Mfg. Co.*, 263 Fed. 713, 718 (1920).

Further, the decision of the Court of Appeals bypassed the subsidiary facts found by the District Court (FF 24, 28-32, R. 376-379) that the device in Johnson Claims 1 and 2, if those claims were broad enough to comprehend the accused Aldek device, preexisted in the prior art. In this further respect, the decision below rejects the contrary authority of the *Cimiotti* and *Dalton Adding Machine* cases, making unavailable as an asserted equivalent one already known to the art.

The above authorities, which appear to be controlling authorities establishing non-infringement herein as a matter of law upon the subsidiary facts found by the District Court in the instant case, were completely ignored by the Court of Appeals and hence rejected as totally inapplicable.

*Emphasis ours throughout.

In the more than fifty-five years since this Court's decision in the *Cimiotti* case it has been thought to be controlling on infringement issues such as those herein until its rejection in the case at bar. The importance to the industrial community of the standards of law governing questions of equivalency regarding machines with parts relatively intercooperating, merits the reversal of the decision below herein and the assurance of this Court as to the continued viability of the *Cimiotti* test. And this is of equal importance where as in the case at bar the conflict is created sub silentio, but nevertheless will be noticed by the patent bar, and others interested, as a departure from the principles previously established by this Court.

3. The decision of the Court of Appeals is in direct conflict with the long-established rule of this Court as set forth in its decision in *McClain v. Ortmayer*, 141 U.S. 419 (1891). In order for Johnson Claims 1 and 2 to embrace the Aldek scaffold, they must be enlarged so as to erase the specific limitation Johnson imposed on himself of the location of his detachable connection at the bottom of his stairway. In order that Aldek infringe these claims, they must cover a stairway scaffold which folds by any of the means asserted by plaintiffs below but not in fact ever conceived (see FF. 6, 13 R. 369-370, 372). But even had Johnson's mental concept been so broad as to embrace the Aldek machine, the rule of *McClain v. Ortmayer* specifically confers on the public the right to appropriate the portion of the alleged broader invention which was not claimed in the patent. This Court said in that decision (141 U.S. at 423):

> "Nothing is better settled in the law of patents than that the patentee may claim the whole or only a part

> of his invention, and that if he only describe and claim a part, he is presumed to have abandoned the residue to the public."

The basis for decision in *Colgate-Palmolive-Peet Co. v. Lever Bros. Co.*, 90 F.2d 178 (7th Cir. 1937) is similarly contrary to the decision below with respect to an asserted—but not claimed—invention. There the Court held (90 F.2d at 194):

> "* * * However, Lamont chose to make the claims more rigid and specific and must be bound thereby. He chose his own language. We must accept his words as they were presented to, and accepted by, the Patent Office. We are not permitted to rewrite a claim even though Lamont's discovery would have justified a broader one. Nor can we do indirectly, that is by construction, what we can not do directly."

The principles of *McClain* and *Colgate* guard against the stultifying prospect of unknown, and unknowable, pretensions of patent monopoly. When these principles are ignored, the benefits to the public, and the business community especially, of the patent system will be accordingly diminished.

With regard to the complete absence from the Johnson claims (and, in fact, from the patent in suit as a whole) of any conception of the different Aldek means, the decision below is contrary to the governing principles of patent law announced in *Halliburton Oil Well Cementing Co. v. Walker*, 329 U.S. 1, 10-13 (1946). Similarly, the decision below conflicts in principle with the decision of the Eighth Circuit in *Parmelee Pharmaceutical Company v. Zink*, 285 F.2d 465, 471 (8th Cir. 1961), holding that the doctrine of equivalency cannot be used to expand the confines of a special claim, for to do so would override the

requirements of the patent statutes which must initially be met by a patentee.

Further, these authorities conflict with a rule first announced by the Court of Appeals in this case, that a patentee is not limited to the "preferred embodiments shown in the *claims* or drawings." 315 F.2d at 27 (Appendix B, *infra*, p. 32). Such a rule has been rejected outright by this Court. *Continental Paper Bag Co. v. Eastern Paper Bag Co.*, 210 U.S. 405, 419 (1908). See 3 WALKER ON PATENTS (Deller's Ed.) § 450, p. 1681.

4. The decision below conflicts in principle with the decisions in *Falkenberg v. Golding*, 195 F.2d 482 (7th Cir. 1952), and *Westinghouse Electric Corp. v. Hanovia Chem. & Mfg. Co.*, 179 F.2d 293 (3rd Cir. 1949), as to the scope of the doctrine of file wrapper estoppel. The Court of Appeals in the instant case decided, "there was simply no basis for file wrapper estoppel," because, "there was no attempt to recapture, revive, or restore something that had been abandoned or surrendered in the patent office." 315 F.2d at 27 (Appendix B, *infra*, p. 32.) The decisions of the Seventh and Third Circuits in the cases cited, on the other hand, clearly regard an estoppel as arising whenever a patentee in litigation attempts to attribute to the claims of his patent a broader construction and meaning than that which he placed upon them in his representations and admissions in the Patent Office.

Further, the doctrine of file wrapper estoppel even as conceived by the Court of Appeals herein was misapplied (R. 879-880).

5. As to the Fifth Question (conditionally presented): Petitioners sought below a declaratory judgment to the effect that Claims 1 and 2 were invalid (R. 53). [In a case and on a record *wholly* alien to petitioners, a jury decision of validity and infringement was affirmed in *Beatty Safway Scaffold Co. v. Up-Right, Inc.*, 306 F.2d 626 (9th Cir. 1962), cert. den., 83 Sup. Ct. 881 (1963)]. Invalidity as a matter of law was urged upon the Court of Appeals as a ground for affirmance of the judgment of the District Court. We seek reversal of the judgment of the Court of Appeals, and affirmance of the judgment of the District Court, upon such ground here as well. *Stelos Co. v. Hosiery Motor-Mend Corp.*, 295 U.S. 237 (1935).

Petitioners urge that under the District Court's subsidiary finding 32 (R. 378-379), Section 4888 of the Revised Statutes (old 35 U.S.C. § 33) in effect at the time of the Johnson application, and the decision of this Court in *Halliburton Oil Well Cementing Co. v. Walker*, 329 U.S. 1, 10-13 (1946), require that if the Johnson patent be "interpreted" so as to cover the Aldek scaffold it is void.

Petitioners also urge the invalidity of Johnson Patent Claims 1 and 2, upon the authority of *Great A. & P. Tea Co. v. Supermarket Equip. Corp.*, 340 U.S. 147 (1956). The pertinent prior art disclosures are already the subject of complete findings of fact herein, FF 22-32 (R. 376-378), and testimony that mere mechanical skill was involved in designing the Johnson scaffold over the prior art was undisputed (R. 310-315, 168-169). *None* of the prior art disclosures in FF 24-31 was before the Patent Office when it issued the Johnson Patent (R. 400).

CONCLUSION

For the above reasons, this petition for writ of certiorari should be granted.

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned, a member of the Bar of this Court, hereby certifies that a copy of the foregoing Petition for Writ of Certiorari was this day served upon counsel for the respondent herein, by depositing same in a United States Post Office, with first-class postage prepaid, addressed as follows:

Oscar A. Mellin, Esq.
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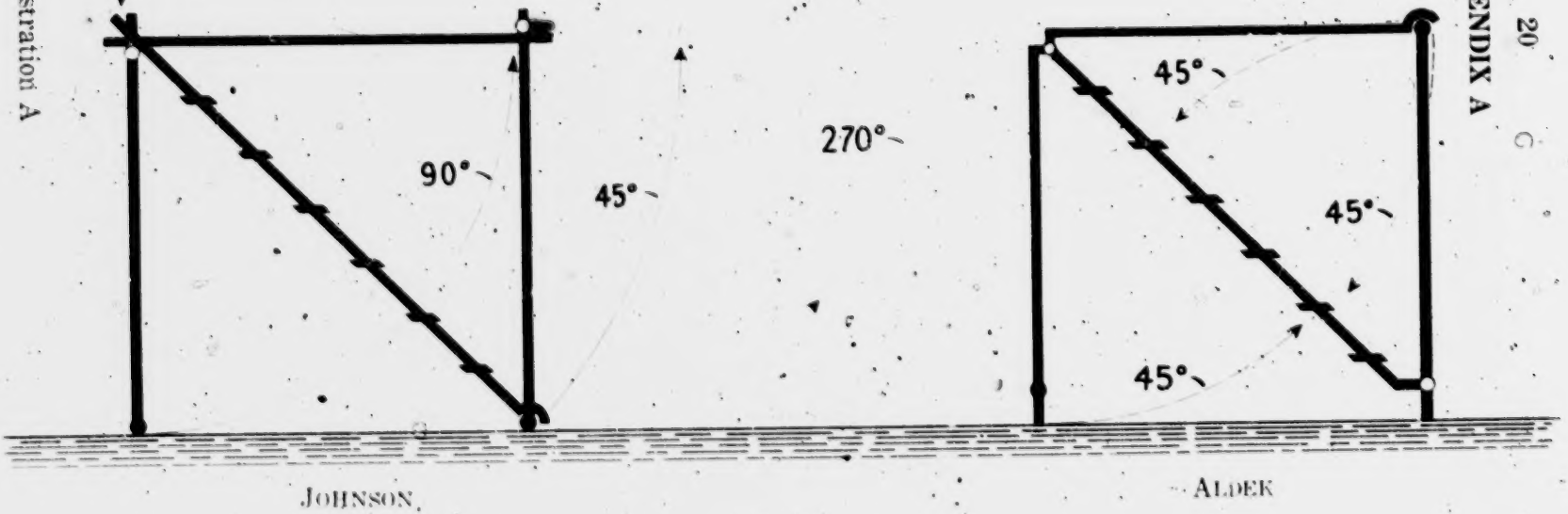
Dated: July 26, 1963.

MARVIN S. SLOMAN

APPENDICES

Illustration A



JOHNSON

ALDEK

The following salient differences in the Johnson and Aldek devices are apparent from Illustration A:

	JOHNSON	ALDEK
(a)	Has hinges at both ends of platform sections where end sections adjoin.	Has hinged connection at left and detachable connection at right, where end sections adjoin platform.
(b)	Hinged connection at right where end section adjoins; is offset upward, important to flat folding.	Platform section attaches radially at upper right.
(c)	Ladder section is hinged at upper left only, and is detachable at lower right. Ladder is offset-hinged upward.	Ladder section is hinged at both ends. Upper ladder hinge is a "straight", or radial, hinge.
(d)	Ladder section is straight, and attaches radially to bottom of end frame.	Ladder section is bent or angled off a straight line, at one end, to achieve flat folding; offsetting is important to parallel flat folding.
(e)	Johnson folds about a horizontal platform section.	Aldek folds about a diagonal ladder section.
(f)	In collapsing, (i) left end section and ladder section rotate to fold against bottom of *platform section*, and (ii) right end section rotates to fold against top of *platform section*.	In collapsing, (i) left end section rotates to fold against "bottom" of *ladder section*, and (ii) beginning first the platform section and then following it the end section rotate to fold against "top" of *ladder section*.

(Continued)

	JOHNSON	ALDEK
(g)	In collapsing, the right end section must be swung out far beyond the erected-framework outlines of the unit, and up and over and then down on top of the platform section, through an arc of 270°.	In collapsing, every member is rotated through an arc of 45° only. Every force is directed to work within the erected-framework outlines, and every member follows an arcuate path within the erected-framework outlines only.

The two devices are shown as when collapsed, in photographic exhibits of record—Johnson in Ex. DI-4 (R. 490) and Aldek in Ex. DI-55 (R. 724). The following salient differences are apparent from a comparison of the folded devices:

	JOHNSON	ALDEK
(h)	The bottom leg ends are pointed in opposite directions.	The bottom leg ends are pointed in the same direction.
(i)	The ladder section protrudes, without protection for the gooseneck connections.	The ladder section is contained in the principal outlines of the "package", and the right end section protrudes with the leg ends protected by the casters.
(j)	The "package" so viewed is 3 tube diameters thick, Package thickness is approximately 6½ inches.	The "package" so viewed is (and must be because of principle and method of folding) 4 tube diameters thick. Package thickness is approximately 8½ inches.

APPENDIX B

OPINION OF THE COURT OF APPEALS

[Caption Omitted]

(March 29, 1963)

Before BROWN and Bell, Circuit Judges and SIMPSON, District Judge.

BELL, Circuit Judge: Suit for infringement of United States Leters patent No. 2,438,173 relating to portable, collapsible scaffolding units was brought against Safway Products, Inc., a distributor of the accused Aldek Scaffold. R. D. Werner Co., Inc., the manufacturer of the Aldek scaffold, was permitted to intervene. The charge of infringement was limited to claims 1 and 2 of the patent in suit.[1] Two general issues; invalidity and infringement, panned out of the prolix pleadings so often prevalent in patent litigation. The issue of infringement involved the subsidiary issue of file wrapper estoppel.

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[1] Claim 1 -- A scaffold unit comprising a rigid platform section, a rigid supporting section at each end of the platform section, a hinged connection betwen adjoining ends of the platform and supporting sections, a ladder section hingedly connected at one end to the end of one supporting section at the junction between it and the platform section, and a detachable connection between the other end of the ladder section and the other supporting section at the end of the latter opposite its connection with the platform section."

Claim 2 — Same as claim 1 with the following additional clause added at the end thereof:

". . ., and a brace extending between, the supporting sections and detachably connected thereto at coinciding points intermediate the end thereof."

The court, upon reaching its decision, advised counsel for the parties of its views by letter, and this letter was made a part of the judgment. It follows in pertinent part. The reference to the Johnson patent is to the patent in suit.

"Gentlemen:

"Having heard and viewed the evidence presented and studied thoroughly the excellent briefs presented to the court, I have determined that plaintiffs' Johnson patent has not been infringed by the accused Aldek device of Defendant and Intervener. Plaintiffs' patent, a combination patent in a very old and crowded art which embodies no new individual elements, is entitled at most to only a very narrow range of equivalents. The accused device does not fall within this range. The Aldek device is simpler, safer and more efficient in operation, and is substantially and materially different in structure, mode of operation, and result.

"It is therefore unnecessary to decide the issue of the validity of plaintiffs' Johnson patent.

* * *"

Thereafter findings of fact, conclusions of law, and final judgment were entered.

The patent in suit covers an integrally connected assemblage of scaffold elements which may be easily erected for use as a tower type scaffold unit, and which may be easily collapsed or folded into a relatively small compact package for transportation or storage. The essential part are permanently connected together by hinged joints, thus eliminating the loss of parts, and increasing the ease with which the scaffold may be handled and stored. Each unit includes a ladder. The units may be placed when erected, one on top of the other, to reach desired heights.

Appellant, assignee of the patent, was founded to manufacture and distribute scaffolds made to the teachings of the patent. Some 53,000 units have been manufactured and sold for use in construction and maintenance work, and as one piece folding radio tower sections. There was testimony describing the erection of a 350 foot high tower in one day. The United States Government has taken a license under the patent so that they may be manufactured by others for the government. The Army Signal Corps has purchased units valued at more than one million dollars, and they are used in forming towers, including use on the Distant Early Warning System in northern Canada. They are also used by the major telephone companies in the United States. Sufficient units can be loaded on a single truck to erect a 200 foot high tower.

These units are simple in design. They are of open frame or tubular construction. Each consists of a platform section hinged to two end or support sections with a diagonal ladder section hinged at the juncture of the platform and one of the end sections. The design is based on a triangular conception with one end section, the ladder section and the platform section forming the triangle. The other end section supports the corner of the triangle where the ladder is affixed at the juncture of that end section and the platform, and is perpendicular to the platform and parallel to the opposite end section when the unit is in the erected position. The ladder is used for the purpose of ascending to and descending from the platform section. The width of the ladder takes up one half of the width of the supporting ends

of the platform section, leaving room for a deck covering the other half of the platform section from which to work. Additional units may be stacked, one upon the other, by fitting the legs of the upper unit into holes provided in the four corners of the end sections of the lower unit. As noted in Footnote 1, the only difference between claims 1 and 2 is the brace between the end sections added in claim 2. It is not involved in this litigation.

The crux of the infringement controversy lies in the difference between the device made according to the specifics of the patent, and the accused device. It is necessary in order that the unit be foldable and portable that one end of the triangle be detachable. The patent sets out the point of detachment as being where the lower end of the ladder joins the bottom of the end section, i.e., the end side of the triangle. The other corners of the triangle are hingedly connected, as is the end section which is not a side of the triangle, but which, along with the opposite end, supports the platform.

The patent in suit, immediately preceding the claims, provides:

> "While we have shown the preferred form of our invention, it is understood that various changes may be made in its construction by those skilled in the art without departing from the spirit of the invention as defined in the appended claims."

The differences between the device of the patent and the accused device are nil for the purposes of this litigation insofar as they appear erected. Such differences as form the issue of infringement are two, one resulting from

the other. Rather than having the ladder detachable from the bottom of the end section which forms a side of the triangle, appellees have put the point of detachment where the platform joins the end section of the triangle. The ladder, on their device, is hingedly connected at each end but occupies the same diagonal position as taught in the patent. This change results in a different folding and unfolding method. In substance, the only change has been to move the point of detachment of the triangle from one corner to another.

The resulting difference in folding and unfolding occurs in two respects; in movement, and in the form of the folded package. The device of the patent in the folded or collapsed position is the thickness of three of the metal tubes forming the framing of the unit. The end which does not form a part of the triangle lies on the bottom of the package with the ladder on top of it, fitting partially into the open part of the platform section which comes next above the ladder, and with the end section which is a part of the triangle resting on top, making the folded package.

It is erected from a folding position, as the erector faces the package, by swinging the end piece which is on top through a one hundred eighty degree arc to the right so that it is again parallel to the ground and an extension of the original package. Next the platform and end section are raised at the joint where the platform hinges to the now extended end section. This in turn commences the forming of a triangle consisting of the end piece, platform and ladder, pulling the outer end of the end section back

toward the package until the bottom of the ladder section can be attached to the rung on the bottom of the end section. Finally, the opposite end of the platform is raised until the platform is parallel to the ground and the opposite end section, which is not a side of the triangle and which is on the bottom of the package, swings into place parallel to the other end section. As erected the end pieces are perpendicular to the platform and the ladder is in a diagonal position. This procedure is reversed to collapse and fold the device of the patent.

The accused device in the folded position is the height of four tubes. The end section, which forms a side of the triangle, rests at the top of the folded unit or package. The platform section is next, then the ladder, with the other end section being on the bottom. It is erected by raising the top end section to the right through an arc of forty five degrees; the platform section is then raised until it can be attached to the already raised end section. At this point the basic triangle has been formed consisting of one end section, the platform section and the ladder section. Finally, the platform section is raised so that it is parallel to the ground. As this is done the remaining end section swings into place, parallel to the other end section and perpendicular to the platform.

The change which results from a selection of a different corner of the triangle as the detachable corner is evidenced by the fact that no member of the accused device moves more than ninety degrees in the folding or unfolding process, while in the device of the patent it is necessary to

move the end piece forming the side of the triangle two hundred seventy degrees. However, on examination this is a difference of little distinction.

No evidence was offered as to the difference in time required to erect or fold either of the units, but the trial court did witness a demonstration and concluded that the accused device was simpler, safer and more efficient in operation, and also that it was substantially and materially different in structure, mode of operation, and result from the device of the patent. Coupling this with the finding that the combination patent of appellant pertained to an old and crowded art, embodied no new elements, and was entitled at most to a narrow range of equivalents, the court concluded that there was no infringement. The court concluded that there was no wide interest beyond that of the parties in the validity or invalidity of the patent and did not reach that question. We hold that the court erred on the question of infringement, and in not reaching the question of invalidity.

It has, of course, been held that it is not necessary for the court to rule on validity in an infringement case where a narrow improvement patent is involved and its validity vel non is of no great public importance. *Industrial Instrument Corporation v. The Foxboro Co.*, 5 Cir., 1962, 307 F. 2d 783; and *Stewart-Warner Corporation v. Lone Star Gas Company*, 5 Cir., 1952, 195 F. 2d 645. But we pointed out in *Industrial Instrument Corporation*, citing *Sinclair & Carroll Co., Inc. v. Interchemical Corporation*, 1945, 325 U. S. 327, 65 S. Ct. 1143, 89 L. Ed. 1644, that the better practice

is to inquire fully into validity. And the question here is important. The facts show a substantial public interest in this patent, and the question of validity also bears heavily on the question of infringement.

We begin with the proposition that an inventor, with respect to his patent, is entitled to a range of equivalents commensurate with the scope of his invention. *Southern Saw Service, Inc. v. Pittsburgh-Erie Saw Corporation*, 5 Cir., 1956, 239 F. 2d 339. We are not here dealing with a pioneer patent but considerable improvement in the scaffold art does appear to have resulted from the teachings of this patent. A comparison with the prior art makes this clear. It is true that every element in the scaffold of the patent is old in the art but none had apparently thought of this particular combination or the result that it obtained. The District Court recognized that the patent was entitled to the protection of a limited range of equivalents, but held that the accused device did not fall within the range. We are unable to discern that any range was applied. Finding file wrapper estoppel, and relying on the specific language of the claims, appellants were restricted to the scaffold unit of the patent.

And in reaching our conclusion we proceed under the authority of *Cameron Iron Works v. Stekoll*, 5 Cir., 1952, 242 F. 2d 17:

> ". . . that where, as here, the facts are undisputed and the case can be determined by a mere comparison of the structure, and extrinsic evidence is not needed for purposes of explanation or evaluation of prior art,

> or to resolve questions of the application of descriptions to subject-matter, the question of infringement may be determined as a question of law, . . ."

See also *Industrial Instrument Corporation v. The Foxboro Co.*, supra, where it was pointed out that:

> "We may reverse free of the clearly erroneous rule where, as is the case here, the issue revolves around an ultimate fact question as distinguished from subsidiary fact questions, or where mixed questions of law and fact are presented when there is error as to the law. Galena Oaks Corporation v. Scofield, 1954, 5 Cir., 218 F. 2d 217. 5 Moore's Federal Practice, 2 Ed., § 52.03(3) p. 2631; Baron and Holtzoff, Wright Ed., Fed. Practice and Procedure, § 1137, p. 560."

The facts of this case meet both tests. The only dispute concerns the ultimate fact question as distinguished from subsidiary facts, and even the subsidiary facts are not in dispute. The prior art needs no explanation and the structures are simple in design. And, under the circumstances, we assume the validity of the patent.

The views of the District Court regarding file wrapper estoppel may have been the prime cause of the error on the question of infringement. In the original application, claims 1 and 2 contained, instead of the words "a hinged" and "hingedly" as they now appear, the words "an articulate" and "articulately", respectively. This change or amendment was required to meet the rejection of the claims by the examiner. The term "articulate" was used, according to appellees, in the sense of "consisting of segments united by joints". Appellees argue that appellant is estopped to claim more than what was agreed to in the

patent office. They contend that by accepting the substitute terms, the restriction of the claim is not only to "hinged" connections instead of "articulate" connections but that the "hinged" connections as distinguished from the "detachable" connection must be located as the claims set out. This would leave appellees, as they did, free to choose another corner of the triangle for the detachable connection, but this connection fails. The location of the detachable connection was in no wise changed by the new language. It continued to be located where it was originally stated to be located. The substitution of hinged connections for articulate connections at the non-detachable points in no way indicates an abandonment of the principle of a detachable corner, or a restriction as to its location. There was simply no basis for file wrapper estoppel. There was no attempt to recapture, revive, or restore something that had been abandoned or surrendered in the patent office. Cf. *Edward Valves, Inc. v. Cameron Iron Works, Inc.*, 5 Cir., 1961, 286 F. 2d 933.

Having eliminaated the question of file wrapper estoppel from the case, we apply the doctrine of equivalents to determine the question of infringement. And in so doing, we adhere to the established rule that the patent was not limited to the preferred embodiments shown in the claims or drawings. See *Continental Paper Bag Company v. Eastern Paper Bag Co.*, 1908, 210 U. S. 405, 28 S. Ct. 748, 52 L. Ed. 1122; *Thurber Corporation v. Fairchild Motor Corporation*, 5 Cir., 1959, 269 F. 2d 841; *Bryan v. Sid W. Richardson, Inc.*, 5 Cir., 1958, 254 F. 2d 191; and *Cameron Iron Works v. Stekoll*, supra. We approach this question on the

assumption of validity, and without making any determination that the patent is to be accorded anything more than a narrow range of equivalents.

The law is that substance is not to be subordinated to form so as to deprive one of the benefit of his invention. And it is settled that if the accused device performs substantially the same function in substantially the same way to obtain substantially the same result, it infringes. *Graver Tank & Mfg. Co. v. Linde Air Products Co.*, 1949, 339 U. S. 605, 70 S. Ct. 854, 94 L. Ed. 1097; *Bryan v. Sid W. Richardson, Inc.*, supra; and *Industrial Instrument Corporation v. The Foxboro Corporation*, supra.

The accused device is not only identical in appearance to the device made from the patent, but it performs the same function and obtains the same result in substantially the same way. It differs in structure only by having the detachable corner of the triangle at one corner of the triangle rather than at another. The evidence was clear from a court-room demonstration, indeed undisputed; that the accused device was operable, when the detachable corner of it was moved to the corner taught by the patent. The evidence was also clear that the device of the patent was operable when its detachable corner was moved to the corner used on the accused device. Either, with the change, could be used commercially with minor mechanical adjustments.

The mode of operation, i.e., folding and unfolding, differs in the manner and degree heretofore described, and this difference results entirely from the selection of a different detachable corner. It results in a simpler folding

and unfolding procedure, and no doubt a somewhat safer procedure than that of the device of the patent. All movement of the parts of the accused device takes place within the perimeter of the unit, whereas one end of the device of the patent in the folding and unfolding procedure protrudes its full length beyond the perimeter of the device of the patent. We hold that this, however, is not such substantiality of difference in the mode of operation as to be without the range of even the narrow equivalents which we accord this combination patent. The accused device under the doctrine of equivalents clearly infringed the claims of the patent in issue, and we reverse in this respect.

We remand the case for a determination of validity.[2] If the patent was or is in fact valid, it nevertheless would have little, if any, value if such a minor change as was made in the accused device could avoid infringement. A finding of validity would have posed the question in the District Court of the worth of the patent in the light of the alleged infringement.

[2]The patent in suit was held valid and infringed in *Beatty Safway Scaffold Co. v. Up-Right, Inc.*, 9 Cir., 1962, 306 F. 2d 626, cert. den., March 4, 1963, 31 Law Week 3281. The accused device there was no different in form from the accused device here.

Of course, it was not the same device and defense counsel here are different. There was apparently no showing of finding there that the accused device was safer or more efficient but both are inherent in any examination of a device such as that accused.

REVERSED and REMANDED for further proceedings not inconsistent herewith.

A true copy
Test: EDWARD W. WADSWORTH
Clerk, U. S. Court of Appeals, Fifth Circuit
By Clair R. James
Deputy
New Orleans, Louisiana, June 20, 1963

LETTER-OPINION OF THE DISTRICT COURT

United States District Court,
Northern District of Texas.
Dallas 21, Texas.

June 20, 1961.

Chambers of
Joe Ewing Estes
Chief Judge

E. Hastings Ackley
Wilson Bldg.
Dallas 1, Texas

Mellin, Hanscom & Hursh
Oscar A. Mellin
391 Sutter St.
San Francisco 8, Calif.

Carrington, Johnson & Stephens
Mr. Paul Carrington & Mr. Marvin Sloman
1700 Mercantile Bank Bldg.
Dallas 1, Texas.

Gentlemen:

Having heard and viewed the evidence presented and studied thoroughly the excellent briefs presented to the court, I have determined that plaintiffs' Johnson patent has not been infringed by the accused Aldek device of Defendant and Intervener. Plaintiffs' patent, a combination patent in a very old and crowded art which embodies no new individual elements, is entitled at most to only a

very narrow range of equivalents. The accused device does not fall within this range. The Aldek device is simpler, safer and more efficient in operation, and is substantially and materially different in structure, mode of operation, and result.

It is therefore unnecessary to decide the issue of the validity of plaintiffs' Johnson patent.

The court is further of the opinion that no attorney's fees should be awarded in this case.

Defendant and Intervener will prepare and submit findings of fact, conclusions of law, and judgment in accordance herewith.

Very truly yours,

JOE E. ESTES
U. S. District Judge

JEE:b

FINDINGS OF FACT AND CONCLUSIONS OF LAW OF THE DISTRICT COURT.

[Caption Omitted.]

The above-entitled cause came on regularly for trial and the Court having duly considered the evidence, and being fully advised in the premises, now makes the following:

Findings of Fact.

1. Plaintiff Up-Right Inc. ("Up-Right") is a California corporation having its executive offices and a manufacturing plant at Berkeley, California, and a manufacturing plant at Teterboro, New Jersey. Plaintiff Wallace J. S. Johnson ("Johnson") is the majority stockholder and president of Up-Right. Up-Right is the owner of U. S. Patent No. 2,438,173 (the "Johnson patent"), which is the patent in suit, issued to Johnson as co-inventor and assignee of Thomas Harvey.

2. Intervener-Defendant R. D. Werner Co., Inc. ("Werner") is a Pennsylvania corporation with its executive offices and a manufacturing plant at Greenville, Pennsylvania. It is the manufacturer of a folding stairway scaffold device (the "Aldek" scaffold) alleged by plaintiffs to infringe Claims 1 and 2 of the Johnson patent. Werner is the owner of U. S. Patent No. 2,941,616 issued to Charles F. Grover and Richard L. Werner, assignors to Werner; the Aldek scaffold is the scaffold illustrated, described and claimed in said patent. Defendant Safway Products Inc. ("Safway") is a Texas corporation with its principal office

in Dallas, Texas. Safway is a distributor of the Aldek scaffold.

3. Plaintiffs charge defendants with infringement of Claims 1 and 2 of the Johnson patent by the manufacture and sale by Werner, and the sale by Safway, of the Aldek scaffold.

4. Each defendant contends it has not infringed Claims 1 and 2 of the Johnson patent by the manufacture and/or sale of the Aldek scaffold, or otherwise. Each defendant contends that Claims 1 and 2 of the Johnson patent are invalid on the grounds of overclaiming and failure to comply with Rev. Stat. 4888 (former 35 U.S.C. § 333, now U.S.C. § 112), and alternatively on the grounds of lack of patentability over the prior art.

5. Claim 1 of the Johnson patent is for "a scaffold unit comprising a rigid platform section, a rigid supporting section at each end of the platform section, a hinged connection between adjoining ends of the platform and supporting sections, a ladder section hingedly connected at one end to the end of one supporting section at the junction between it and the platform section, and a detachable connection between the other end of the ladder section and the other supporting section at the end of the latter opposite its connection with the platform section." Claim 2 of the Johnson patent is identical to Claim 1, except for the addition of the following: ". . . . and a brace extending between the supporting sections and detachably connected thereto at coinciding points intermediate the ends thereof."

6. Plaintifs claim (Pre-trial Brief) that the invention which Johnson produced, and which is embodied in the Johnson patent, consists of, "A one-piece folding scaffold unit comprising:

"(1) four major elements (platform, two ends, ladder)

"(a) three of which (platform, end and ladlader) form a triangle, and

"(b) the fourth (other end) connects at a corner of the triangle;

"2) four connections (three hinge and one detachable)

"(a) in which the three corners of the triangle are formed by two hinge connections and one detachable connection, and

"(b) in which a hingle connection connects the other end to one corner of the triangle."

and "without specfying one out of the three corners of the triangle for the detachable connection."

7. The disclosure of the Johnson patent is confined to a specific scaffold unit which in the erected structure is interconnected, has two rigid end sections, a rigid platform section, a diagonal ladder section (Claim 1); and a brace between the end sections in order to position vertically the end section opposite the end section to which the bottom of the diagonal ladder is connected (Claim 2), as in Figures 1 and 3 of the Johnson patent. The disclosure of the Johnson patent is confined to a specific scaffold unit in which, in the structure in any condition, the two rigid end sections

are hingedly connected to the respective ends of the platform section, the upper end of the diagonal ladder section is hingedly connected at the intersection of the platform section and one end frame, and the lower end of the diagonal ladder section is detachably connected at the lower end of the opposite end frame.

8. The disclosure of the Johnson patent is confined to a specific scaffold unit in which in folding for collapsing the erected structure (hereafter "collapsing"), the brace in Claim 2 is disconnected entirely from the unit; the free end section is rotated inwardly and the remainder of the unit is rotated downwardly, toward each other through an arc of 45° until the free end section lies as close as possible to the ladder section, which is at this point almost horizontal; the lower end of the ladder section is disconnected from the transverse frame member at the lower end of the end section to which the bottom of the ladder is detachably connected in the erected structure; that end section is rotated outwardly and up and over and down, through an arc of 270°, until lying flat on top of and parallel to the platform section, and at the same time lowering the platform section through an arc of 45° until next to the ladder and free end section with the ladder and free end section lying flat on the underside of and parallel to the platform section. The disclosure of the Johnson patent is for a specific scaffold unit collapsing in practice with the foregoing mode of operation, as in Figure 3 of the Johnson patent, though the steps in each mode of operation are stated in a different order; not employed in actual practice, in the description in the Johnson patent.

9. The disclosure of the Johnson patent is confined to a specific scaffold unit in which the members are relatively positioned by offsetting so as to fold into a compact package in the manner described in Finding No. 8 employing the hinged connections and detachable connections particularly located as set forth in Claims 1 and 2, and collapsing by rotation of end members and the ladder member about (that is, rotating and then coming to rest above and below) the platform member.

10. The disclosure of the Johnson patent is confined to a specific scaffold unit in which, in the collapsed structure the end section to which the bottom of the ladder section detachably connects lies flat on top of and parallel to the platform section, and the free end section (after removal of the brace set forth in Claim 2) lies flat on the underside of and parralel to the platform section, making a flat compact package of approximately three tube diameters' thickness, as in Figure 3 of the Johnson patent and the description therein.

11. The discloure of the Johnson patent is confined to a specific scaffold unit in which in unfolding (hereafter "erecting"), the steps described in the actual mode of collapsing in Finding No. 8, are followed in reverse.

12. The Johnson patent does not contain any disclosure of any scaffold other than a particular folding stairway scaffold in which the erected structure is as described in Finding No. 7, in which folding is as described in Finding Nos. 8, 9 and 11, and in which the collapsed structure is as

described in Finding No. 10. There is no indication or mention in the Johnson patent that the subject matter of the alleged invention therein was as plaintiffs claim, as set forth in Finding No. 6. On the contrary, the disclosure of the Johnson patent is limited to the specific embodiment of the scaffold, as above set forth.

13. The evidence does not support plaintiffs' contention that the subject matter of the alleged invention was as claimed by plaintiffs as set forth in Finding No. 6. The evidence on the whole is to the contrary.

14. The file wrapper of Patent No. 2,438,173 shows that Johnson and Harvey in order to secure their patent substituted "hinged" for "articulate" and "hingedly" for "articulately" in Claims 1 and 2, during the prosecution of their application in the Patent Office. They represented to the Patent Office, in order to distinguish the alleged invention over the discoveries of earlier inventions cited by the Patent Office as primary references in rejecting the claims as filed, that they considered the distinguishing features of the alleged invention over the prior art to be (1) "the hinged connection of the platform section to the end supporting sections", (2) "a ladder which is hinged to one end of an end and supporting section and detachedly secured to the opposite end of the other supporting section, so as to provide a diagonal brace", and (3) hinged connections which allowed "all of the parts to be folded upon one another".

15. No reissue of the Johnson patent broadening the specific claims for the device in Claims 1 and 2 of the

Johnson patent has ever been sought, applied for or received. More than two years have elapsed since the issuance of the Johnson patent on March 23, 1948.

16. Each of Claims 1 and 2 of the Johnson patent calls for a structure in which the bottom of the ladder section is detachably connected to the lower end of the end frame to which the bottom of the ladder is connected, and in which the platform section is hingedly connected to the top of both end frames. The Aldek scaffold does not have or embody a structure with such connections or any equivalent structure.

17. The Aldek scaffold has a hinged connection at both ends of its ladder section, and has a detachable connection at the juncture between the top of the end section to which the bottom of the ladder adjoins and the platform section. Further, in order that the Aldek scaffold may fold into a flat compact package ,it has for use with its particular interconnections different relative relationships between its various elements and different offsetting between those elements, than the scaffold device claimed, described and disclosed in the Johnson patent. Use of the particular detachable and hinged connections employed by Aldek in the device otherwise claimed, described and disclosed in the Johnson patent, without other changes, would make the Johnson device inoperable.

18. The Aldek scaffold does not have or embody a mode of operation like that in the spcific scaffold unit to which the disclosure of the Johnson patent is confined, nor any equivalent mode of operation. To the contrary, the Aldek

scaffold platform and end members fold about (that is, fold flat against and parallel to the upper side and under side of) the ladder section rather than the platform section as in the Johnson device—with the end secton to which the bottom of the ladder section is hingedly connected, and then the platform section, lying on the upper side of the ladder section and with the free end section lying on the underside of the ladder section. In collapsing and erecting the Aldek structure, the end section to which the ladder is hingedly connected, and the platform section, rotate through arcs of 45° only, rather than the arc of 270° through which the Johnson device end section to which the bottom of the ladder attaches and must rotate. In the last stage of collapsing or the first stage of erecting the Aldek scaffold, one member, only, at a time is rotated through its arc, of 45°, rather than the simultaneous rotation in the Johnson device of the end section to which the bottom of the ladder attaches through an arc of 270° and the platform section simultaneously through an arc of 45°.

19. In the Aldek scaffold when collapsed, the bottom leg ends are pointed in the same direction, with the lower ends of the free end section protruding from the main portion of the collapsed package. In the specific Johnson device to which the disclosure of the Johnson patent is limited, the bottom leg ends are pointed in opposite directions, with the detachably connecting end of the ladder section protruding from the main portion of the collapsed package.

20. The Aldek scaffold reaches different results from the specific device to which the Johnson patent disclosure

is limited. The Aldek scaffold is simpler mechanically, and is simpler to operate, and is thus faster to operate and more efficient. Safety is of paramount importance in scaffolding, and particularly in towers where one or more units are erected one on top the other as the Johnson and Aldek scaffolds often are. Aldek is safer for the above reasons, which result in a stronger feeling of security on the part of the operator. The Aldek scaffold is also safer because it avoids the tendency of imbalancing on account of the outward swing of 270° in the Johnson device.

21. The Aldek scaffold has a different structure, a different mode and principle of operation, and different results from the structure claimed, described, or disclosed in the Johnson patent.

22. The Johnson patent is not a pioneer patent, it being simply an improvement patent in a very crowded field.

23. Claims 1 and 2 of the Johnson patent are "combination" claims, the alleged invention residing entirely in the combination of the elements recided therein, rather than in the elements themselves, each of which was old and well known at the time the application for the Johnson patent was filed.

24. Johnson and Harvey were not the inventors of the folding scaffold, as such. They were not the inventors of the diagonal stairway scaffold in which the stairway served the dual function of bracing the structure and getting a workman up and down. They were not the inventors of a portable and collapsible scaffold structure with Johnson's

four or five elements (the Johnson device consisting of five elements including the extra crossbrace) which could be erected and collapsed by employing the principle of a folding triangle with two hinged connections and one detachable connection. They were not the inventors of a scaffold unit relatively proportioned to accomplish flat folding.

25. The following references, each of which preceded Johnson and Harvey's original filing date by more than one year, are directly pertinent items of prior art, but were not considered by the Patent Office during prosecution of said application:

Blomgren and Anderson Patent No. 69,168.

Baker Patent No. 406,617.

"Safety Engineering as Applied to Scaffolds", The Travelers Insurance Company, 1915.

Interior diagonal stairway scaffolds used in construction of the San Francisco-Oakland Bay Bridge, 1934-1935; in the Herald Square Building in New York City, 1940; and in construction projects on many other occasions since the early part of the century.

Martin Patent No. 1,912,947.

Boeing Aircraft Company portable diagonal stairway scaffold, used beginning about 1941 until 1944 toward the end of World War II. Published in "Air Transport" magazine for May, 1945.

Southern California Wind Tunnel scaffold, used beginning in 1941 until recently.

Cederquist Patent No. 2,312,148.

26. Each of the references in Finding No. 25 not represented by patents, was used publicly more than one year prior to the filing date of the Johnson patent. Each of the publications referred to were published more than one year prior to the application for the Johnson patent.

27. The following publications, showing the Southern California Wind Tunnel scaffold structure were published before the actual alleged invention was made by Johnson and Harvey:

"Engineering and Science Monthly" for July, 1945.

"Aircraft Production" magazine for August, 1945.

28. The use of a diagonal stairway in a scaffold structure is old and has been employed since the early part of the century; and use of a diagonal interior stairway in scaffolding is unpatentable over the prior art. "Safety engineering as Applied to Scaffolds"; San Francisco-Oakland Bay Bridge; Herald Square Building.

29. A erected tubular portable structure with rigid end sections, a rigid platform section, and a diagonal ladder section serving the dual function of bracing the structure and providing a way up and down the structure is within the prior art, as shown in Boeing Scaffold ("Air Transport" magazine for May, 1945) and Southern California Wind Tunnel ("Engineering and Science Monthly" for July, 1945).

30. A folding scaffold with two rigid end sections, a rigid platform section, and a ladder section, portable and collapsible, relatively proportioned to accomplish flat folding, and which was erected and collapsed by employing the method and principle of a folding triangle with two hinged connections and one detachable connection at the corners of the triangle, was known to the prior art. Cederquist Patent, No. 2,312,148.

31. Flat-folding of interconnected elements by means of offsetting members, use of offset hinges or otherwise, involves mechanical skill only, and was known to the prior art. Tayor Patent No. 2,312,602; Martin Patent No. 1,912,-947; Cederquist Patent No. 2,312,148.

32. If the specific language of Claims 1 and 2 of the Johnson patent were stretched by interpretation to cover the Aldek scaffold, the claims would embrace an alleged invention broader than the patented invention in Claims 1 and 2; no reissue patent was sought or applied for within two years after the date of issue of the Johnson patent.

33. The device claimed, described and disclosed in Werner Patent No. 2,941,616 for the Aldek scaffold was issued by the Patent Office over the device disclosed in the Johnson patent. I find as facts from the evidence in the record other than the determination of the Patent Office to issue the Werner Patent that such Aldek device is different in structure, mode of operation and results from the device in the Johnson patent.

From the foregoing facts the Court now makes the following:

Conclusions of Law

1. Plaintiffs have no cause of action against defendant and intervener for alleged infringement of U. S. Patent No. 2,438,173 (the Johnson patent).

2. Plaintiffs have the burden of proving infringement. Plaintiffs have failed to sustain their burden of proof that defendant and intervener have infringed Claims 1 or 2 of the Johnson patent. On the contrary the record in the case clearly shows that all of the claims of the Johnson patent are limited to a particular form of folding scaffold and that these claims are not infringed by the accused folding scaffold.

3. Claims 1 and 2 of the Johnson patent are for a combination of elements, the claimed combination consisting in each case, among other things, of a detachable connection at the bottom of the ladder section and hinged connections at each end of the platform section at the juncture of the same with the end sections. Since the Aldek scaffold does not have a detachable connection at the bottom of its ladder section, and at one end of its platform section does not have a hinged connection; and since the Aldek scaffold has an entirely different mode of operation and operative functioning, and reaches different results from the Johnson device, and thus is not the equivalent thereof, the Aldek scaffold cannot infringe either of Claim No. 1 or Claim No. 2 of the Johnson patent.

4. When setting out the nature of his invention and the scope of his claims in the prosecution of his patent before the Patent Office, plaintiff made the representations set forth in Finding of Fact No. 14, which were relied upon by the Patent Office in granting plantiff's patent; plaintiff is then estopped from asserting a broader or more liberal interpretation of the claims of his patent in this suit for infringement than the interpretation which the plaintiff gave to those same claims during the prosecution of the patent.

5. The Johnson patent is a combination patent in a very old and crowded art and not a prioneer patent. It is entitled only to a very limited range of equivalents, and the accused device does not fall within this range of equivalents.

6. The issuance of U. S. Patent No. 2,941,616 covering the Aldek scaffold does not create any presumption that the Aldek scaffold does not infringe Johnson Claims 1 and 2. In determining the question of infringement as a fact, the action of the Patent Office in granting the Aldek patent is entitled to be considered along with other evidence in the record upon the fact question of whether, between the two devices, there is a substantial difference.

7. Where as in this case non-infringement is clear and there is no wide interest in the commercial community beyond the interests of the parties themselves in the validity of the patent, the Court in its discretion may determine not to reach the question of validity. I so determine not to reach the question of validity of the Johnson patent.

8. Intervener-defendant Werner contends that he is entitled in the discretion of the Court to the recovery of an attorney fee under 35 U.S.C. § 285. The Court is of the opinion that no attorney's fees should be awarded in this case.

9. The action must be dismissed and judgment entered for defendant and intervener, with costs against the plaintiffs.

Let judgment be entered accordingly.

Dated: June 30, 1961.

JOE E. ESTES,
United States District Judge.

JUDGMENT OF THE COURT OF APPEALS

[Caption Omitted]

Before Brown and Bell, Circuit Judges, and Simpson, District Judge.

JUDGMENT

This cause came on to be heard on the transcript of the record from the United States District Court for the Northern District of Texas; and was argued by counsel;

ON CONSIDERATION WHEREOF, It is now here ordered and adjudged by this Court that the judgment of the said District Court in this cause be, and the same is hereby, reversed; and that this cause be, and it is hereby, remanded to the said District Court for further proceedings not inconsistent with the opinion of this Court;

It is further ordered and adjudged that the appelles, Safway Products, Inc. and R. D. Werner Co., Inc., be condemned, in solido, to pay the costs of this cause in this Court for which execution may be issued out of the said District Court.

March 29, 1963

Issued as Mandate: June 11, 1963

Recoverable Costs:	
Docketing Cause, etc.	$ 25.00
Cost of Printing Record	1631.75
	$1656.75

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In the Supreme Court

OF THE

United States

OCTOBER TERM, 1963

No. 318

SAFWAY PRODUCTS, INC. and R. D. WERNER CO., INC.,

Petitioners,

vs.

U-RIGHT, INC.,

Respondent.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Fifth Circuit

BRIEF FOR RESPONDENT IN OPPOSITION

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On Petition for a Writ of Certiorari to the United States Court of Appeals for the Fifth Circuit

BRIEF FOR RESPONDENT IN OPPOSITION

Respondent respectfully asks that the writ be denied.

PRELIMINARY STATEMENT

In this brief we will refer to pages in the brief and petition of petitioners as "P.B. . . .", and to the appendix to the petition and brief of petitioners as "P.A. . . ."

OPINIONS BELOW

The opinion of the Court of Appeals for the Fifth Circuit is reported at 315 F.2d 23, and is printed at P.A. 23-34.

The opinion of the District Court for the Northern District of Texas is unreported but is printed at P.A. 35-36.

JURISDICTION

The jurisdictional requisites are adequately set forth in the petition at P.B. 2.

QUESTIONS PRESENTED

The first three questions presented by petitioners may be rephrased as follows:

In an action for patent infringement, when a trial court makes findings of ultimate facts of infringement, based upon the application of the doctrine of equivalents to the patent in suit, the accused device and the prior art devices, is an appellate court bound by the rule that findings shall not be set aside unless clearly erroneous, or may an appellate court draw its own conclusions as to the ultimate question of infringement.

The fourth question presented by petitioners may be rephrased as follows:

Whether the appellate court below was correct in reviewing the prosecution in the Patent Office of the patent in suit, and in determining as a matter of law that the doctrine of file wrapper estoppel did not preclude

respondent from charging that the manufacture of petitioners' accused device is an infringement of the patent in suit.

The fifth question presented by petitioners concerns the question of validity of the patent in suit (a matter not yet determined by the District and Circuit Courts below) and may be rephrased simply as follows:

Whether the patent in suit is valid.

STATEMENT OF THE CASE

The present case is a typical suit for patent infringement. The essential facts are related with clarity and precision in the detailed and exhaustive opinion of the Court of Appeals. The following merely highlights the factors of particular significance.

Respondent is the owner of United States Letters Patent No. 2,438,173 for a portable and collapsible scaffolding unit, and brought suit for infringement based upon the manufacture and sale by petitioners of the accused scaffold.

Respondent's patent in suit, respondent's commercial scaffold, petitioners' accused scaffold and the prior art patents, publications and uses were all before the District Court. The scaffold devices are not complicated and the construction and operation of each device is readily understood. There was no dispute whatsoever as to the existence, construction and operation of the scaffolds of petitioners or respondent or of any of the prior art devices. There was some dispute in the testimony as to

the degree of speed, efficiency and safety of the patented and accused scaffolds, but such testimony in no way brought into dispute the construction, operation or intended result of these scaffolds.

The District Court concluded, upon a consideration of the construction and operation of the scaffolds and prior art before it, that the respondent's patent was entitled at most to only a small range of equivalents, and that the accused device did not fall within that range. The District Court also concluded that petitioners' scaffold was materially different in structure, mode of operation and result from the patented scaffold.

Having found non-infringement, the District Court declined to pass upon the validity of the patent in suit.

Detailed findings were adopted setting forth the construction and operation of the devices involved in the suit.

The Court of Appeals had before it the patent in suit, petitioners' and respondent's commercial scaffolds, and the prior art. The folding and unfolding of petitioners' and respondent's scaffolds was demonstrated at the oral argument. The opinion of the Court of Appeals indicates that it understood clearly the construction and operation of the devices involved in the suit.

The Court of Appeals then concluded that the patented and accused scaffolds were not substantially different in construction, operation and results, and that the District Court improperly applied the doctrine of equivalents to the patent in suit. The Court of Appeals decided that the accused device came within the scope of the claims of the patent in suit and that infringement did exist.

The Court of Appeals also reversed the District Court on the question of file wrapper estoppel and held that the respondent was not estopped by any of the proceedings in the Patent Office, to charge that the accused scaffold was an infringement of the patent in suit.

The case was remanded to the District Court for a determination of the question of validity. Thereupon, petitioners filed their petition for writ of certiorari.

ARGUMENT

CERTIORARI SHOULD NOT BE GRANTED TO REVIEW THE QUESTION OF INFRINGEMENT OF THE PATENT IN SUIT

This case turns on a determination of a question entirely peculiar to this case: Does the manufacture and sale of petitioner's scaffold infringe the claims of the patent in suit?

There is no dispute about the legal test that governs. If the accused device performs substantially the same function in substantially the same way to obtain substantially the same result as the patented device, then there is infringement. This has been clearly set forth by this Court in *Graver Tank & Mfg. Co. v. Linde Air Products Co.*, 339 U.S. 605 (1949), and was followed by the Court of Appeals below (P.A. 33).

Applying this test, the Court of Appeals held the accused scaffold to infringe the patent in suit. In reaching its conclusion, the Court of Appeals considered the patent in suit, accused scaffold and the prior art. These were not complicated devices, and there was no dispute

as to the existence, construction, operation or intended purpose of any of these devices. No testimony was necessary to explain the meaning of any terms of the patent or prior art, nor to resolve questions of the application of descriptions to subject matter.

The ultimate question decided by the trial court and appellate court was whether, from an examination of this undisputed evidence, infringement existed, that is, whether the accused scaffold and the scaffold of the patent in suit were substantially the same in construction, mode of operation and result. The trial court believed that an extremely narrow range of equivalents existed and held that there was no infringement. Upon an examination of the same undisputed devices, the Court of Appeals concluded that the patent was entitled to a broader range of equivalents and held that infringement did exist. In making its determination of this ultimate fact, the Court of Appeals was in as good a position to make such a determination as the District Court.

Petitioners now contend that the Court of Appeals is bound by the ultimate finding of the District Court regarding the question of infringement, and that the District Court cannot be reversed unless its determination of infringement is clearly erroneous. However, this court has long held in patent cases that if no evidence is needed to explain terms of art or to apply the descriptions of patents to the subject matter, and if the court is able from mere comparisons of the patent, accused device and prior art to determine whether the accused device is the same or different from the patented device, then the question of infringement is one of pure construction and

not of evidence and, consequently, is a matter of law for the court. *Heald v. Rice*, 104 U.S. 737 (1882); *Singer Mfg. Co. v. Cramer*, 192 U.S. 265 (1904); *Sanitary Refrigerator Company v. Winters*, 280 U.S. 30 (1929), *United States v. Esnault-Pelterie*, 303 U.S. 26 (1938).

The same rule is followed by the various circuits, namely, that in cases wherein the ultimate fact of infringement may be determined merely by a comparison of the patent and accused devices, the appellate court is not bound by the "clearly erroneous" rule. *Hanovia Chemical & Mfg. Co. v. David Buttrick Co.*, 127 F.2d 888 (C.A. 1, 1942); *Plax Corporation v. Precision Extruders*, 239 F.2d 792 (C.A. 3, 1957); *Industrial Instruments Corporation v. The Foxboro Co.*, 307 F.2d 783 (C.A. 5, 1962); *Del Francia v. Stanthony Corp.*, 278 F.2d 745 (C.A. 9, 1960).

The present case is not in conflict with the decisions of this Court in *Graver Tank & Mfg. Co. v. Linde Air Products Co.*, 336 U.S. 274 (1949) and 339 U.S. 605 (1950) where extensive testimony of experts was necessary to explain the subject matter of the suit in a field "where so much depends upon familiarity with specific scientific problems and principles not usually contained in the general storehouse of knowledge and experience" (339 U.S. at 610). The field of endeavor of collapsible scaffolds is not one which is incomprehensible to courts of law.

Petitioners also contend that the Court of Appeals is in error because it held the patent to be infringed even though the claims did not read literally on the accused scaffold. This is not erroneous, but follows the rule laid down by the Court in the *Graver* case, 339 U.S. 605, 607:

". . . One who seeks to pirate an invention, like one who seeks to pirate a copyrighted book or play, may be expected to introduce minor variations to conceal and shelter the piracy. Outright and forthright duplication is a dull and very rare type of infringement. To prohibit no other would place the inventor at the mercy of verbalism and would be subordinating substance to form. It would deprive him of the benefit of his invention and would foster concealment rather than disclosure of inventions, which is one of the primary purposes of the patent system. . .

* * *

". . . Though infringement was not literal, the changes which avoid literal infringement are colorable only. . . ."

CERTIORARI SHOULD NOT BE GRANTED TO REVIEW THE QUESTION OF FILE WRAPPER ESTOPPEL

In the present case the petitioners had relied upon the doctrine of file wrapper estoppel to escape liability for their infringement. The Court of Appeals, after a study of the file wrapper (the written history of the prosecution in the Patent Office) of the patent in suit, concluded that respondent was not estopped to charge petitioners with infringement.

This question, dependent upon the particular facts of this case, is not sufficient to warrant review by this Court.

General Talking Pictures Corp. v. Western Electric Co., 304 U.S. 175 (1938).

". . . Whether respondents acquiesced in the infringement and are estopped depends on the facts. Grant-

ing of the writ would not be warranted merely to review the evidence or inferences drawn from it. . . ."

There is no conflict in law of this case with the decisions in *Falkenberg v. Golding*, 195 F.2d 482 (C.A. 7, 1952) or *Westinghouse Electric Corp. v. Hanovia Chem. & Mfg. Co.*, 179 F.2d 293. In those cases it was held that, upon the facts presented, the patentee was estopped to charge infringement because he was attempting to recapture, revive or restore something which he had abandoned or surrendered in the Patent Office. In the present case, upon the facts here presented, the Court of Appeals held that there was no basis for file wrapper estoppel because the patentee did *not* try to recapture, revive or restore something that had been abandoned or surrendered in the Patent Office. Thus, the only conflict between the cases is in the final result of whether file wrapper estoppel applies, and not in the rule of law followed by the courts.

CERTIORARI SHOULD NOT BE GRANTED TO ADJUDICATE THE VALIDITY OF THE PATENT IN SUIT

The question of the validity of the patent in suit is premature. The District Court made no determination as to validity. The Court of Appeals made no determination as to validity, but has remanded this question to the District Court.

Furthermore, even if the Court of Appeals had held the patent in suit to be valid so that petitioners could seek review of that decision, then there would be no conflict between circuits, since the same patent has

already been held to be valid in the Ninth Circuit in *Beatty Safway Scaffold Co. v. Up-Right, Inc.*, 306 F.2d 626 (C.A. 9, 1963).

CERTIORARI SHOULD NOT BE GRANTED MERELY TO GIVE PETITIONERS ANOTHER HEARING

The determination by the Court of Appeals that petitioners have infringed respondent's patent rests on an *appraisal of the particular facts of this case*, and an appreciation of the particular circumstances of this case. As the Court has often said, it does not exercise its certiorari jurisdiction to review this kind of determination, or to give an unsuccessful party in a court of appeals another hearing.

> *Magnum Import Co. v. Coty*, 262 U.S. 159 (1923)
>
> ". . . The jurisdiction to bring up cases by certiorari from the Circuit Courts of Appeals was given for two purposes, first to secure uniformity of decision between those courts in the nine circuits, and second, to bring up cases involving questions of importance which it is in the public interest to have decided by this court of last resort. The jurisdiction was not conferred upon this court merely to give the defeated party in the Circuit Court of Appeals another hearing. . . ."

CONCLUSION

For the reasons set forth above, the petition for a writ of certiorari should be denied.

Dated, San Francisco, California,
August 20, 1963.

Respectfully submitted,

OSCAR A. MELLIN,
CARLISLE M. MOORE,
Attorneys for Respondent.

MELLIN, HANSCOM & HURSH,
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OCTOBER TERM, 1963

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SAFWAY PRODUCTS, INC. AND
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v.

UP-RIGHT, INC.,
Respondent.

PETITIONERS' MEMORANDUM IN RESPONSE TO RESPONDENT'S BRIEF IN OPPOSITION

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PETITIONERS' MEMORANDUM IN RESPONSE TO RESPONDENT'S BRIEF IN OPPOSITION

---

1. At the core of respondent's argument concerning Rule 52 (a)—though the Rule and its criteria are not mentioned in respondent's brief—is the erroneous premise that this case in the trial court involved only undisputed facts. Such an assumption is wholly inaccurate, and respondent does not and could not furnish any authority from the record for the statements in respondent's brief to such effect. The record of recurring conflicts in the evidence, reflecting sharply disputed issues of fact, is to the contrary (see R. 872-878). A summary of these as arising in the testimonial evidence appears in a footnote on page 7 of the petition herein, and is not contradicted by respondent.

Such disputes were most heavily concentrated upon issues relating to modes of operation and to results of the respective devices, though to some extent they concerned structure. Now respondent itself admits (Brief pp. 3-4) that there was dispute concerning the comparative speed, efficiency and safety of the Johnson and Aldek devices—in other words as to "result". The assertion that there was no dispute as to the "intended" result of the devices is a word game concerning the irrelevant.

The Court of Appeals saw no demonstration of the comparative mechanics of the devices in question (R. 877). It did not even see upper sections of the devices. It saw no demonstrations of the kinds such as were witnessed in the courtroom and outside the courtroom by the trial judge, as detailed at page 7 of the petition.

We emphasize that petitioner is not, as respondent appears to suggest (Brief, p. 10), here seeking another hearing on the facts. Petitioner complains it was error for the Court of Appeals to conduct in its deliberations a *de novo* hearing and to make in its decision a *de novo* determination, of the evidentiary and ultimate facts. The Court of Appeals simply stepped around any question of whether the findings of the District Court were "clearly erroneous", as provided by the Rule. Second, the Court had before it only the cold print of testimony without any opportunity to judge of the credibility of five live witnesses, and made simply no allowance for the trial court's opportunity to do so, as provided by the Rule. In addition, the Court of Appeals had no opportunity at all, as had the trial court, to observe a score of instances of the

operation and results in the field, of upper and lower scaffold sections of the devices in question; modifications of those devices made and offered in evidence by *respondent*; and prior art devices.

An attempt to redetermine the facts without being able to take into account these matters ignores the spirit as well as the letter of Rule 52(a). See the note of the Advisory Committee (1937) to Rule 52, set forth in 5 MOORE'S FEDERAL PRACTICE, ¶52.01[4]. We are confident that any trier of fact who was able to consider all these would reach the same result as the District Court did upon them. We are not seeking that the facts be decided again here. Such an attempt would be as impossible a task for this Court as it was for the Court of Appeals, if any meaning is given Rule 52(a). Respondent's argument (Brief, p. 7), compatable with the approach of the Court of Appeals herein, would render Rule 52(a) practically meaningless by stripping it of any applicability in a case which is "not incomprehensible to courts of law." But such an argument and such an approach are in direct conflict with the *Graver Tank* decisions of this Court, and the Seventh Circuit *Kennatrack* and *Bailey* decisions, all cited at page 11 of the petition herein.

2. Petitioners presented under questions 2 and 3 (Petition, pp. 2-3) certain questions of law germane to the issues of infringement in this case. Adherence to prior decisions of this Court and Courts of Appeals, pertinent to such questions, would require a holding of noninfringement in this case as a matter of law. The conflicts between such decisions and the decision of the Court of Appeals herein are discussed at pages 12-13, and 14-16, of the petition.

Respondent has not attempted by argument to discuss these conflicts. It has, however, attempted to restate the questions presented by petitioners, and thereby to omit petitioners' questions 2 and 3. We do not concur in the form of questions as stated by respondent, and we do not join in its purported elimination of these matters of law from the case.

3. For the reasons set forth herein and in the Petition for Certiorari, review of this case should be granted.

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned, a member of the bar of this Court, hereby certifies that the foregoing brief was this day served upon Messrs. Oscar A. Mellin and Carlisle M. Moore, counsel for the respondent herein, by depositing same in a United States Postbox, with first class, air mail postage prepaid, addressed to their law office address of record herein.

Dated: September 23, 1963.

MARVIN S. SLOMAN